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CENTRAL FAX CENTER

PATENT APPLICATION
ATTORNEY DOCKET NO. 10992503-1

OCT 03 2005

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Masumi Senoo

Application No.: 09/506,418

Filing Date: 02/17/2000

Title: Distributed Rendering of Print Jobs

Confirmation No.: 7752

Examiner: BRINICH, Stephen

Group Art Unit: 2624

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on 08/12/2005. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

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Number of pages: 7

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Respectfully submitted,

Masumi Senoo

By Steven R. Sponseller

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Inventor Senoo et al.
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Examiner Brinich, Stephen M.
Attorney's Docket No. 10992503-1
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REPLY BRIEF

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In response to Examiner's Answer mailed August 12, 2005, in connection with Applicant's Appeal Brief filed May 25, 2005, a Reply Brief is submitted. Favorable consideration is respectfully requested.

Claims 1-12 and 14-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,003,069 to Barry Richard Cavill (hereinafter "Cavill") in view of Appellant's admitted Prior Art.

Applicant respectfully submits that the standard for obviousness under 35 U.S.C. §103 is not satisfied by Cavill in view of Appellant's admitted Prior Art with respect to claims 1-12 and 14-18. Accordingly, Applicant disagrees with the Office's final rejection (from which an appeal has been made) and with the Examiner's Answer, to which this Reply responds.

Examiner's Allegation Regarding Grouping of Claims

On Page 2 of the Examiner's Answer (Mailed August 12, 2005), under the heading "(7) Grouping of Claims", the Examiner alleges "The rejection of claims 1-12 and 14-18 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7)."

Appellant respectfully notes that 37 CFR 1.192 was removed and reserved on September 13, 2004. Thus, the Examiner has cited a rule that is no longer effective.

Appellant submits that that claims 1-12 and 14-18 do not stand or fall together. Appellant notes that the old rules regarding "grouping" of claims are no longer effective. Appellant argued the following sets of claims separately in the Appeal Brief: 1. Claims 1-7; 2. Claims 8-12 and 14; 3. Claims 15-18.

37 CFR 41.37(c)(1)(vii) states (in part):

... For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by the appellant, the Board may select a single claim from the group of claims

that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number....

Appellant has complied with 37 CFR 41.37(c)(1)(vii) by placing claims argued as a group under a subheading identifying the claims by number (e.g., "Claim 1 of the present application recites:"). Thus, Appellant submits that the three separate sets of claims do not stand or fall together and are to be considered separately.

Appellant submits that the Examiner's statement with respect to the grouping of claims on Page 2 of the Examiner's Answer is incorrect and should be withdrawn.

Response to Arguments in Examiner's Answer

Page 5 of the Examiner's Answer (Mailed August 12, 2005) states "Examiner takes the position that it would be obvious to one of ordinary skill in the art to incorporate the local network computer of Cavill into the printer of Cavill (providing advantages such as simplified setup and more compact packaging by avoiding the need to provide this computer as a separate element externally interfaced with the printer)."

Appellant submits that the Examiner has improperly used hindsight to create a printer of Cavill that contains a local network computer. Such combination is not disclosed or suggested by Cavill. Further, Appellant's admitted Prior Art merely mentions the use of a print engine in a printer and makes no mention or suggestion of incorporating a local network computer into

a printer. Further, the combination of Cavill and Appellant's admitted Prior Art fails to suggest a printer containing a local network computer. Only through the use of impermissible hindsight based on the teachings of the present application can such a creation occur.

Appellant submits that Cavill and Appellant's admitted Prior Art lack any suggestion that the local network computer and printer of Cavill can be combined in the manner suggested by the Examiner. It is not sufficient for the Examiner to merely state that the prior art discloses the components of the claimed invention. Instead, the Examiner must show that the prior art itself suggests that those components or teachings should be combined.

Cavill discloses a client/server printer driver system. "In essence, the driver is split between the NC and the server, with each part performing the tasks that are best suited for the systems on which they reside." (Cavill, col. 2, lines 56-59). Thus, the focus of Cavill is the separation of the printer driver between the network computer and the server. Cavill makes no reference or suggestion to put a network computer in the printer. Since the Cavill disclosure describes the separation of the printer driver, there is no reason for Cavill to even mention the idea of placing the network computer within a printer. Such a discussion would not be relevant to the separation of the printer driver between a server and a network computer. Additionally, the Figures of Cavill show the printer device as a separate component that is not part of the server or the network computer.

Further, the Examiner has not identified any disclosure or suggestion in Cavill to incorporate the network computer into the printer. The Examiner merely states that such incorporation might provide "simplified setup and more

compact packaging". Again, the Examiner fails to provide any support in Cavill for such an assertion.

Combining Cavill with Appellant's admitted Prior Art fails to correct the deficiencies of the Examiner's argument. Appellant's admitted Prior Art discloses a printer having a print engine. Appellant's admitted Prior Art makes no mention of incorporating a network computer into a printer. To the contrary, Appellant's admitted Prior Art states "Although this type of printer contains its own print rendering engine, it is typically coupled to a processing device, such as a computer, to receive the raw print job data generated, for example, by an application running on the computer". (Emphasis Added) (Present Application, Page 2, lines 3-6). Thus, Appellant's admitted Prior Art fails to suggest incorporating a computer (such as a network computer) into a printer. Instead, Appellant's admitted Prior Art teaches away from such action by stating that the printer is typically coupled to a computer.

Since neither Cavill nor Appellant's admitted Prior Art make any statement regarding incorporating a network computer into a printer, such an allegation is based on impermissible hindsight.

Accordingly, Appellant submits that Claims 1-12 and 14-18 are allowable for at least the reasons discussed in the Appeal Brief filed May 25, 2005 along with the reasons discussed herein.

Conclusion

Applicant respectfully submits that all of the Office's rejections have been traversed. As such, Applicant respectfully submits that all of the claims are in condition for allowance.

Respectfully Submitted,

Dated: 10-03-05

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